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REMARKS/DISCUSSION OF ISSUES

The §112 rejection

The rejection of claims 1-18 as failing to comply with the enablement requirement is traversed. The Examiner's rejection is unsupported and contrary to clear law. An Applicant's specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex does not make it undue. For computer related inventions, the specification need only enable a skilled artisan to configure the computer to possess the requisite functionality without the exercise of undue experimentation. See, MPEP §2106(B)(2). The Examiner's allegation that he can "find no evidence in the specification of what the difference between metadata information and metadata objects and the defined difference is essential to enable the invention" is entirely irrelevant.

When basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of §112, the examiner must establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971). See, MPEP 2106.01. The Examiner has failed to do so.

Additionally, the Examiner's allegation that there is no definable difference between metadata information and metadata objects is not relevant, even if true, to an enablement rejection. The Examiner's allegation that the claim contains subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention is unsupported by evidence.

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In the event that the Examiner intends to maintain this rejection, the Examiner needs to support his argument with *evidence* defining the level of skill possessed by one of ordinary skill in the art and the level of experimentation typically engaged in by those of skill in the art. Applicants maintain that those of skill in the art are familiar with the concepts of metadata and possess sufficient skill to make and use the claimed invention without undue experimentation.

With respect to the Examiner's confusion relating to differences between data and data objects, Applicants respectfully point to page 1, columns 7-12, wherein Applicants note that metadata objects may refer to instances of "classes persisted to a file, relational or object-oriented database or simply rows in tables in a relational database." In other words, a "data object" is a file containing data. Additionally, the difference in meaning is further made clear in the discussion of page 1, lines 16-23.

Withdrawal of the §112 rejections is requested.

The §101 rejection

The §101 rejections are traversed as contrary to law. The Examiner's allegation that "all of these claims fail to produce any sort of concrete and tangible result" is legally insufficient, even if true, to support a utility rejection.

Additionally, claims 7, 10, 13, and 16 recite "a computer" or "a computer program product" which are, in fact, concrete and tangible objects.

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The §103 rejection

The §103(a) rejections of claims 1-18 as unpatentable over Egilsson in view of Chester is traversed. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See MPEP 2143. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Rayka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP 2143.03. Applicants respectfully assert that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The mere fact that Egilsson can be modified in view of Chester to obtain the claimed invention as recited in claims 1-18 does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Frisch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

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The basis for the Examiner's allegation is simply that "it would have allowed easy import and export of files in a standard format". However, the Examiner cannot conclusively assert that use of the Chester "conversion of spreadsheet files into CSV files" would assist in the creation of an "application building and managing environment in which users of computer systems, including ones with minimal programming knowledge, create and share powerful software applications. See, Egilsson, col. 1, lines 12-16. This is particularly true in light of the fact that Egilsson does not denounce its graphical environment for managing and developing applications as anything less than an ideal solution to the problems, and in light of the fact that Chester does not pronounce its "conversion of spreadsheet files into CSV files" as the ultimate method of displaying metadata.

Therefore, the Examiner cannot support this §103(a) rejection over Egilsson in view of Chester, and Applicants request withdrawal of all rejections.

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CONCLUSION

The Applicant respectfully submits that claims 1-18 as listed herein fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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